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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,464	02/07/2001	Jean-Paul Cano	ESSI:005CP1	5911

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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT PAPER NUMBER

1773

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,464

Applicant(s)

CANO ET AL.

Examiner

D. S. Nakarani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 03, 2003 has been entered.

2. Claim 12 is objected to because of the following informalities: Claim 12, line 7 (excluding structural formula), the phrase "R' demotes" should read - - R' denotes - -. Appropriate correction is required.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fail to provide support for open language " ophthalmic lens comprising- - ". The originally filed specification and claims provide support for closed language "ophthalmic lens

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consisting of - ". Therefore invention as claimed in claims 24 is an open language, which is not supported by the originally filed specification, and it constitute new matter.

5. Claims 1-23, 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the (1) abrasion-resistant coating derived from composition of claim 12 and (2) an inorganic antireflective coating having monolayer with optical thickness of $\lambda/4$ where λ is a wavelength between 450 and 650 nm or having multilayer film comprising three layers with a combination optical thickness $\lambda/4.\lambda/2.\lambda/4$ or $\lambda/4.\lambda/4.\lambda/4$, respectively, or equivalent multilayer with similar optical thicknesses (see page 13, lines 21-29), does not reasonably provide enablement for any abrasion resistant coating and any antireflective coating (e.g., U.S. Patent 4,904,525 and Declaration of Philippe Roisin). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification as filed does not teach or suggest hard coating such as organic resin coating, inorganic coating etc. All coating has somewhat abrasion resistant. Addition of coating improves abrasion of stack over stack having no coating. The claimed invention does not claim minimum abrasion resistant. Also there is no disclosure of an anti-reflective coating other than inorganic.

6. Claims 1-3, 5, 6, 10, 11, 13, 15, 18 and 20 –24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi et al (U.S. Patent 4,904,525) for the reasons of

record set forth in paragraph 7 of the Office Action mailed October 11, 2002 (paper No. 8).

7. Applicant's arguments filed November 3, 2003 have been fully considered but they are not persuasive.

In reference to rejection of claim(s) under 35USC §112 first paragraph with respect to changing phrase "consisting of" to the phrase "comprising" constituting new matter, applicants state the delimiting nature of the phrase "consisting of" is applied only to the claims." Consisting of" is a term of art that serves to measure the scope of the claims, not the specification. In the specification this phrase takes its ordinary meaning.

These arguments are unpersuasive because in the patent application the phrase "consisting of" has same meaning whether it is in the claims or in the specification. There is nothing on record showing that the phrase "consisting of" in the specification takes its ordinary meaning. Applicants have not provided any evidence showing that in the patent language phrase "consisting of" has different meaning in the specification than in the claim. Furthermore, the specification as filed describes only claimed layers. There is no disclosure of additional layer (s). Therefore changing the closed language phrase "consisting of" to the open language phrase "comprising" is a new matter.

In reference to rejection of claims 1-26 under 35 USC §112, first paragraph, applicants state that the Examiner is incorrect in stating that any abrasion – resistant coating will improve the abrasion resistance of the final product. Thus, impact resistant

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enhancing layers having low glass transition temperature (T_g) and/or made of thermoplastic material or with low cross-linking will usually lower the abrasion resistance of the final product.

These arguments are unpersuasive because the Examiner has not stated that any abrasion resistant coating will improve the abrasion resistance. The Examiner has stated that any additional layer will provide improvement. Furthermore there is no evidence provided showing that layer having low glass transition temperature and/or made of thermoplastic material or with low cross-linking will lower abrasion resistant of final product.

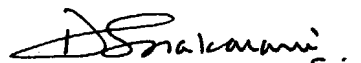
In reference to rejection of claims 1-3, 5,6,10,11,13,15,18,20 and 21 under 35USC § 103(a) as being unpatentable over Taniguchi et al (U.S. Patent 4,904,525), applicants mainly state as per declaration of Philippe Roisin, Taniguchi et al's second fluorosilicone film cannot be considered as an antireflection coating since all stacking include only the hard coat and the second fluorosilicone film have R_m values per face at least 4% much higher than 2.5% which is upper limit value for considering the coating as having antireflective properties.

These argument are unpersuasive because claims 1-21 are not rejected as stated in remark over Taniguchi et al. Taniguchi et al's articles is an anti-reflection optical article. Further there is nowhere in the present application stated argued upper limit of R_m value to consider the coating as having antireflective properties. There is no data showing that the claimed invention has R_m values at or below 2.5%.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau, can be reached on (571) 272-1512. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. S. Nakarani
Primary Examiner
Art Unit 1773

D. S. Nakarani/af
March 11, 2004.